

REMARKS

Claims 1 through 5 and 10 through 16 are pending in this application. Claims 6 through 9 and 17 through 22 have been cancelled. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1 through 22 were rejected under the second paragraph of 35 U.S.C. § 112.

In the statement of the rejection, the Examiner asserted that the claims are indefinite as to where the growth of the first layer is to be performed. The Examiner questioned whether the first layer is grown only in the recesses or over the entire structure including the mask layers. This rejection is traversed.

Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a **question of law**.

Personalized Media Communications LLC v. U.S. International Trade Commission, 161 F.3d 696, 48 USPQ2d 1880 (Fed. Cir. 1998); *Tillotson, Ltd v. Wlaboro Corp.*, 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. § 112, the Examiner must provide a basis in fact and/or cogent technical reasoning to support the ultimate legal conclusion that one having ordinary skill in the art, with the supporting specification in hand, would not be able to reasonably ascertain the scope of protection defined by a claim. *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976). Significantly, consistent judicial precedents holds that **reasonable precision** in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Zoltek Corp. v. United States*, 48 Fed. Cl. 240, 57 USPQ2d 1257 (Fed. Cl. 2000); *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27

USPQ2d 1123 (Fed. Cir. 1993); North American Vaccine, Inc., v. American Cyanamid Co., 7 F.3d 1571, 28 USPA2d 1333 (Fed. Cir. 1993); U.S. v. Teletronics Inc., 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231USPQ (Fed. Cir. 1986). Applicants stress that claims must be interpreted as one having ordinary skill in the art would have interpreted the claims in light of and consistent with the written description of the supporting specification. *Zoltek Corp. v. United States, supra; Miles Laboratories, Inc. v. Shandon, Inc. supra.*

In applying the above legal tenets to the exigencies of the case, Applicants submit that the Examiner did not discharge the initial burden of establishing a *prima facie* basis to deny patentability to the claimed invention under the second paragraph of 35 U.S.C. § 112. Indeed, it is difficult to conceive of one having ordinary skill in the art who would have had any difficulty interpreting the claimed invention in light of and consistent with the written description of the specification. This is because when reviewing the specification it becomes apparent that in each of the disclosed embodiments, as in the first embodiment schematically illustrated in Figs. 1 through 6, for example, the “first nitride-based semiconductor layer” (page 20 of the written description of the specification, line 4), is grown in **stages**. These stages are illustrated in Figs. 4 through 6.

Applicants stress that the first nitride-based semiconductor layer 4 is grown vertically from the recess (Fig. 4). Subsequently, the first nitride-based semiconductor layer 4 is grown laterally, as shown in Fig. 5. The first nitride-based semiconductor layer 4 then coalesces over the mask layers as shown in Fig. 6. Thus, contrary to the Examiner’s assertion, one having ordinary skill in the art is clearly informed of the precise growth pattern of the first nitride-based semiconductor layer 4.

Based upon the foregoing Applicants submit that one having ordinary skill in the art would clearly understand that the first nitride-based semiconductor layer is grown in the recesses and over

the mask layers, as specifically disclosed and as specifically illustrated in the depictions of the disclosed embodiments. Again, the Examiner's attention is invited to Figs 4 through 6.

Applicants, therefore, submit that, **as a legal conclusion**, one having ordinary skill in the art would clearly understand the scope of the claimed invention, particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the **judicial standard**. *Miles Laboratories, Inc. v. Shandon, Inc. supra*.

Applicants, therefore, submit that the imposed rejection of claims 1 through 22 under the second paragraph of 35 U.S.C. § 112 is not legally viable and, hence, solicit withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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